

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 15 and 19 are pending in the present application. No claim amendments are presented, thus no new matter is added.

In the Office Action, Claims 15 and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Davis et al. (U.S. Pat. 6,105,008, herein Davis) in view of Official Notice.

Applicants respectfully traverse this rejection, as independent Claims 15 and 19 recite novel features clearly not taught or rendered obvious by Davis and Official Notice.

Independent Claim 15, for example, recites, in part, an operation method of an authentication and payment system including a terminal, a service providing device, an authentication and payment device, and an information network connecting the terminal, the service providing device, and the authentication and payment device, comprising:

- receiving by the terminal from the authentication and payment device a certificate of service including a content of a reference amount;
- issuing a request for use of a service attached with the certificate of service for the terminal to the service providing device...
- comparing the reference amount in the certificate of service with an amount of payment to determine whether the amount of payment is larger than the reference amount ...
- providing by the service providing device, in a case the amount of payment is equal to or smaller than the reference amount, the requested service to the terminal before the service providing device generates an authentication and payment message that is sent to the authentication and payment device.

Independent Claim 19, while directed to an alternative embodiment, recites similar features.

Turning to the applied reference, Davis describes a process of purchasing goods and/or services over the Internet using a smart card, for example. More particularly, Davis describes that a client terminal receives “debit command” and “a security card signature” from a payment server, and the client terminal transmits “a debit success message”, which is

generated by a smart card such as Stored-Value Card (SVC), “security card signature”, and “card signature” to a merchant server.¹ The merchant server then receives “the debit success message”, “security card signature”, and “card signature” from the client terminal via the Internet, and processes “a debit success message”, and compares the “security card signature” with “card signature”.²

At pp. 3-4, the Office Action concedes that Davis fails to disclose the “comparing” and “providing” features recited in independent Claim 15. However, the Office Action relies on Official Notice asserting that “comparing a sent amount with a pre-determined amount of payment was old and well-known in the art because it allows for determination of payment before providing a service” and “providing a service upon determining that a required amount was paid was old and well known in the art because it allows for a system where a user will not receive provisioning of a service until the full amount has been paid.” (emphasis added)

Claim 15, however, recites “***providing*** by the service providing device, in a case the amount of payment is equal to or smaller than the reference amount, ***the requested service to the terminal before the service providing device generates an authentication and payment*** message that is sent to the authentication and payment device”. In other words, Claim 15 recites that the service providing device provides the requested service “in a case the amount of payment is equal to or smaller than the reference amount” prior to confirming that the full amount has been paid (i.e., ***before the service providing device generates an authentication and payment*** message that is sent to the authentication and payment device). Therefore, in case the amount of payment is less than the reference amount, by providing services first, a user can receive goods and/or services immediately without waiting for the authentication and payment of inexpensive goods and/or services. Thus, the features for which Official Notice are taken are not analogous to the “providing” feature recited in Claim 15.

¹ Davis, Figs. 8 and 14, for example.

² Id.

In apparently identifying the above noted shortcoming in Davis, p. 5 of the Office Action asserts that the conditional feature that “the ‘service providing server’ provides the service to the ‘wireless terminal apparatus ... based on the determination that the amount of payment is less than or equal to the reference amount’” and “the generation of ‘an authentication and payment message that is sent to the authentication and payment server’ is somehow optional. The Office Action supports this position with a conclusory statement that “conditional elements do not narrow the claims because they can always be omitted.” (emphasis added), and cites M.P.E.P. § 2106 II C. However, this cited portion of the M.P.E.P. deals with optional elements and not conditional elements. Applicants respectfully submit that the statements made on pp. 5-6 of the Office Action are incorrect, because there is no case law, nor any passages in the M.P.E.P. stating that conditional claim limitations may be omitted or not given patentable weight. More particularly, conditional claim limitations are not the same as optional claim limitations, and should not be interpreted similarly.

Regarding M.P.E.P. at 2106 II C, these passages explain the following:

... Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) “adapted to” or “adapted for” clauses,
- (C) “wherein” clauses, or
- (D) “whereby” clauses.

(M.P.E.P. at 2106 II C, portions omitted, emphasis original.) It is clear that these passages of the M.P.E.P. do not mention in anything regarding “conditional” claim limitations, and that conditional claim limitations are not to be given patentable weight.

The claim requires the service providing device to provide “the requested service to the terminal” “in a case the amount of payment is equal to or smaller than the reference

amount”. Thus, the claimed method requires the service to be provided when the claimed condition is met.

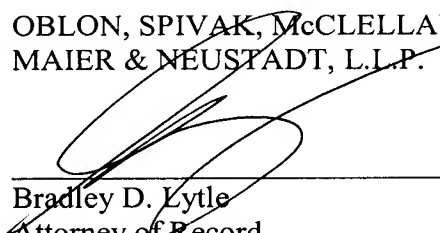
Therefore, Applicants respectfully submit that the entire feature of “*providing ... in a case the amount of payment is equal to or smaller than the reference amount, **the requested service ... before the service providing device generates an authentication and payment message ...***” is not optional, and that Davis fails to teach or suggest the above noted claimed feature.

Accordingly, for at least the reasons discussed above, Applicants respectfully request that the rejection of Claim 15 under 35 U.S.C. § 103 be withdrawn. For substantially similar reasons, it is also submitted that independent Claim 19 patentably defines over Davis.

Consequently, in view of the present amendment and in light of the foregoing comments, it is respectfully submitted that the invention defined by Claims 15 and 19 is patentably distinguishing over the applied references. The present application is therefore believed to be in condition for allowance and an early and favorable reconsideration of the application is therefore requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/09)

Andrew T. Harry
Registration No. 56,959